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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 257,585	02 25 1999	SALLY A. LEONG	P98067US	2444

7590 03 25 2003

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

2003

DATE MAILED 03 25 2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/257,585

Applicant(s)

LEONG ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1 ☐ A Notice of Appeal was filed on \_\_\_\_ Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- 2 ☐ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

- 3 ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
- 4 ☐ Newly proposed or amended claim(s) \_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 5 ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
- 6 ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 7 ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_.

Claim(s) objected to: \_\_\_\_.

Claim(s) rejected: 1-7, 9, 13-14, 16 and 25-26.

Claim(s) withdrawn from consideration: \_\_\_\_.

- 8 ☐ The proposed drawing correction filed on \_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

- 9 ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.

Continuation of 2. NOTE:

New issues: 112, 1st, enablement, claim 26: a bacterium that is transformed with a nucleic acid encoding SEQ ID NO:4 will not necessarily also encode SEQ ID NO:2, as the two open reading frames do not overlap. The specification does not teach how to produce SEQ ID NO:2 from a bacterium not transformed with a nucleic acid encoding it.

Continuation of 3. Applicant's reply would have overcome the following rejection(s): 112, 2nd over claims 6 and 13 and 112, 1<sup>st</sup>, written description over claims 1-7, 9 and 25-26..

Continuation of 5. does NOT place the application in condition for allowance because:

112, 1st, enablement: Applicant urges that nucleic acids that hybridize to SEQ ID NO:1 but do not confer CO39-specific avirulence have utility to detect the presence or expression of AVR1-CO39 genes and to identify homologs from other Magnaporthe isolates; this utility is real world because of the advantage of cultivar-specific avirulence. This is not found persuasive because there is no other Magnaporthe strain that has a functional Co-39 avirulence gene. See Farman et al, cited in the prior Office action. Thus, the nucleic acid of claim 11 has no utility. It is suggested that Applicant delete the recitation under part (c). With respect to claim 1, the specification does not teach that chromosome 1 of strain 2539 comprises any other regions that encode SEQ ID NO:4.

Continuation of 10. Other: It is suggested that claim 1 be amended to claim an isolated nucleic acid encoding SEQ ID NO:4 and that claim 2 be cancelled; the hybridization and source language in the claims unnecessarily limits Applicant - nucleic acids encoding SEQ ID NO:4 can be synthesized, for example to use bacteria-preferred codons, and these nucleic acids would not be isolated from strain 2539 and may not hybridize to SEQ ID NO:1 under the claimed conditions.



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